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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: U.S. Application No. 09/844,511 filed April 28, 2001

Title: "Scalable, Multi-User Server And Method For Rendering Images From Interactively Customizable Scene Information"

Inventors: Thomas Driemeyer and Rolf Herken

Attorney Reference: MENT-059

DECLARATION OF ROLF HERKEN

United States Patent and Trademark Office  
Commissioner for Patents  
Alexandria, VA 22314

Dear Sir or Madam:

1. I am Rolf Herken, President and Chief Executive Officer of Mental Images GmbH, assignee/owner of the above-listed U.S. patent application, and a named applicant/inventor in many of the applications I will discuss in this Declaration, filed in support of the attached Petition.
2. I am writing regarding an issue that my company and I have recently discovered, namely, that the above-listed patent application and 11 others, among the many patent and trademark applications that our outside patent attorney Richard Jordan, Esq. (U.S. Reg. No. 27,807) prosecuted for us before the USPTO, have gone abandoned; even though Mr. Jordan continued to assure us that our patent portfolio, including these applications, was being properly handled by him. It was never our intention to abandon these applications, which are central to the continued success of our company; and we were never advised that they had gone abandoned; and in fact, Mr. Jordan's advice to us was quite the contrary.
3. Mental Images GmbH, based in Berlin, Germany, which I founded in 1986, is in the business of developing and selling computer graphics software. Our software, which includes high-performance methods for rendering images for motion pictures, video games, and other

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applications, is (or has been) licensed to DreamWorks Animation SKG, Inc., Industrial Light & Magic (a division of Lucas Digital Ltd.), Electronic Arts, Inc. and other prominent motion picture, visual effects and video game companies; to the world's leading design and content creation software companies including Microsoft Corp., Alias Systems, AutoDesk, Inc., Avid Technology, Inc., Dassault Systemes SA, and SolidWorks Corp., and other industry users. Our company employs 56 people, eight of them in the U.S., and we have a subsidiary in San Francisco, CA. In March 2003, the American Academy of Motion Picture Arts and Sciences honored the developers of our Mental Ray rendering software product with an Academy Award for technical achievement, making the award to 'Thomas Driemeyer and to the mathematicians, physicists and software engineers of Mental Images for their contributions to the Mental Ray rendering software for motion pictures.'

4. Over the last ten years, our company has spent approximately \$1 million U.S. for the preparation and prosecution of U.S. patent applications and patents, the vast majority of that (i.e., nearly \$100,000/year) in legal fees to Mr. Jordan. For example, during the period January 2003 to April 2005, Mr. Jordan sent us 43 invoices for patent matters, in the amount of approximately \$170,000. (These figures do not include amounts spent by our company for PCT, EP and other national patent applications, or for the equally substantial trademark work undertaken for our company by Mr. Jordan.) The corresponding U.S. patent files occupy approximately 3 meters of shelf space in our company's Berlin offices.

5. We first began working with Mr. Jordan in 1994, and for an entire decade have had an excellent working relationship with him. Mr. Jordan successfully obtained numerous U.S. patents for us, covering our core technology and products, a number of which we currently license out to other companies, and all of which have been a key to our raising investment capital. Mr. Jordan has been responsible for the preparation and prosecution of dozens of U.S. patent applications, including those listed above.

6. Over that approximately ten-year period, I have had frequent and extensive telephone discussions, a fair number of in-person meetings, and an exchange of more than 1000 emails, faxes and other correspondence with Mr. Jordan regarding our company's patent portfolio. In 2002, we had at least 11 telephone conferences; in 2003, at least four telephone conferences; and in 2004 there were at least five telephone conferences.

7. But from the beginning of May 2005, when Mr. Jordan was to have returned from vacation, Mr. Jordan had essentially "disappeared", and would no longer answer my telephone calls, emails,

faxes or other communications. What Mr. Jordan never told us, and what we have now just learned through the work of another patent attorney, is that the above-referenced U.S. patent applications went abandoned, one by one, over the course of years 2001-2005. Perhaps even more baffling, up until his "disappearance", Mr. Jordan acted in a manner that assured us that he was in control of the patent portfolio, even inquiring as to new developments that might warrant the filing of continuation-in-part applications based on (what we now know to be) abandoned patent applications; and filing Information Disclosure Statements in cases where he had (unbeknownst to us) failed to respond to Notices of Missing Parts.

8. At no time prior to just a few days ago did we know that the applications were abandoned, and in fact, Mr. Jordan on several occasions, upon my inquiry, indicated to us that he was in good control of our U.S. patent portfolio.

9. For example, in March 2003 we licensed our software to DreamWorks, whose counsel checked on the status of our patent applications during several telephone discussions with Mr. Jordan in December 2002. The software license was successfully entered into shortly thereafter and is still in force.

10. In mid-2003, the company raised approximately \$6 million in investment money from outside investors. This process included a due diligence review of the patent portfolio by the investors' counsel, which at that time indicated no problems with status. Due diligence, and a review of the relevant patent portfolio, was also conducted by the American Academy of Motion Picture Arts and Sciences prior to their awarding of the 2003 Academy Award for technical achievement to our company.

11. On 7 May 2003, Mr. Jordan wrote to our European patent attorney regarding our MENT-059PCT application (Application No. PCT/IB01/00922). We decided at that time that while enormous progress had been made in converting the invention described in the MENT-059 (U.S. Serial No. 09/844,511) application into a commercial product, the original application covered our invention and we did not see the need to file a divisional application at that time.

12. In January 2004, Mr. Jordan sent email and called me to discuss various patent matters, and as a result of that call I advised co-inventor Thomas Driemeyer that Mr. Jordan had inquired as to any new innovations or improvements to the subject matter of the MENT-059 patent application that might warrant the filing of a continuation-in-part application.

13. Yet despite all this activity, and unbeknownst to us, the MENT-059 application went abandoned in December 2001 for failure to respond to a Notice of Missing Parts that was mailed in June 2001.

14. In March 2004 we discussed with Mr. Jordan an EPO search report and whether it might be prior art to one of the above-referenced U.S. patent applications.

15. In May 2004 we discussed with Mr. Jordan comments by the inventor on our case MENT-066 (U.S. Application 10/439,311) regarding a possible extension of the application (which, unbeknownst to us, went abandoned in January 2004). But in a telephone meeting on 11 November 2004 Mr. Jordan discussed with me in detail an Office Action by the European Patent Office regarding the very same MENT-066 application.

16. Accordingly, at no time until the end of 2004 did I have any information to suggest that there was any problem with the prosecution or status of our U.S. patent applications. In fact, Mr. Jordan on numerous occasions gave every indication of being fully in charge of our U.S. patent applications.

17. In December 2004, however, Mr. Jordan advised us that his computer system had suffered a breakdown, causing the loss of patent docket and other critical data. In response to that, and being concerned about the disruption that might cause, on 19 January 2005 I traveled to Boston for a meeting with Mr. Jordan regarding the company's patent portfolio. I told Mr. Jordan that my company would help him obtain IT assistance for his computer problems, and that we would get him any other assistance that he needed, but that we would need solid information about the status of our applications and any upcoming deadlines, including a status chart. Mr. Jordan indicated that he would need a bit of time to put that together, but promised to send a status chart by the end of March 2005. Mr. Jordan said he would provide a complete status check through the end of March, and that he would also seek to recreate his docket (at that point, over two dozen of what we thought were active U.S. patent applications) from the paper files in his home office.

18. As a result of that January 2005 meeting I arranged for one of our IT specialists to contact Mr. Jordan by telephone to discuss the matter with him and eventually to visit Mr. Jordan's home office to help him with his computer problems. I also spoke to Mr. Jordan by telephone during my stay in Boston (which was prolonged unexpectedly due to a severe snow storm). Mr. Jordan then decided to solve the problem with the help of local technical support. On 24 January 2005 we also sent to Mr. Jordan, at his request, copies of our entire email correspondence with him for the period November 2004 to January 2005.

19. On 16 March 2005 I called Mr. Jordan and spoke with him to check on the status of the various U.S. patent applications. I explicitly asked about the status of the MENT-059 application. He replied that this was still pending and that he had not received an office action. It was left that Mr. Jordan would get back to us with status information. However, I did not receive the noted status chart from Mr. Jordan at the end of March, or thereafter.

20. Thereafter, we continued to attempt to reach Mr. Jordan by email, fax, and telephone, without success. We even tried the Munich telephone numbers we had been given by him on earlier occasions. Our messages were not returned.

21. On 26 April 2005 our "Russian Roulette" patent (No. 6,885,370) issued. We had received from Mr. Jordan a copy of the official Issue Notice relating to this case, but since Mr. Jordan never sent us a copy of the issued patent or various earlier notices (e.g., the Notice of Allowance) – and because this was the first patent that issued "early" or out of the order in which we had submitted the applications -- we began to become concerned about Mr. Jordan's handling of our other U.S. patent applications.

22. However, in March and April 2005, Mr. Jordan filed some trademark applications on behalf of the company and sent us his invoices in early April. He also told me in a telephone conference on 16 March 2005 that he would be traveling to Munich on vacation until the beginning of May, and that while there, he would either observe or participate in the oral argument of one of our corresponding European patent applications (MENT-020PCT) before the European Patent Office on 18 April 2005.

23. Thus, the situation was not entirely clear. Mr. Jordan on the one hand appeared to be proactively handling certain matters, but as to other matters there was ominous silence, and a complete failure to return messages.

24. On 9 June 2005, concerned about the complete lack of any word from Mr. Jordan, we spoke with our corporate counsel, Peter Moldave, Esq. of Gesmer Updegrove, as to whether he knew of anyone who could assist us regarding the patent matters. Mr. Moldave brought in David Jacobs, Esq., a patent attorney and partner of the Gesmer Updegrove firm, who advised that we run a direct check of USPTO records and obtain copies of prosecution histories. Given that there had been absolutely no contact from Mr. Jordan for two months, I also asked Mr. Jacobs what we could do to check on Mr. Jordan's health and well-being.

25. While Mr. Jacobs was conducting a check and obtaining copies of file histories from the USPTO, Mr. Jacobs also attempted to contact Mr. Jordan by telephone (at least one voicemail

message was left on Mr. Jordan's answering machine), fax and email. None of the messages was returned.

26. Also during this process, I asked my cousin, Ulrich Herken, M.D., PhD, who is based in Medford, Massachusetts, to visit Mr. Jordan's home office in Wellesley, Massachusetts, to see if he could contact Mr. Jordan. I briefed my cousin with regard to our concern about Mr. Jordan's failure to contact us or return messages since his presumptive return from vacation at the beginning of May.

27. As my cousin Dr. Herken described it to me in a detailed email on 23 June 2005 (German and English versions attached hereto as Exhibits A and B , respectively), and in further detail in a telephone call the next day, Dr. Herken arrived at Mr. Jordan's house at approximately 5:00 pm on 23 June 2005 and rang the doorbell, but did not immediately receive a response. Dr. Herken went to speak with Mr. Jordan's neighbor, who assured him that Mr. Jordan still lived there and was actually at home. A few minutes later, as Dr. Herken was about to leave, the door to Mr. Jordan's home opened, and someone stepped out to retrieve the newspaper and mail. Dr. Herken approached, identified himself as my cousin, and asked if the individual was Mr. Jordan. The individual, dressed in pajamas, unshaven and initially confused, indicated that he was. When asked why he had not returned messages or otherwise been in communication for almost three months, Mr. Jordan indicated that he had been suffering from a reaction to some medication, but was now feeling better. He indicated that he greatly enjoyed working on the Mental Images patent applications and would soon be sending more work-product.

28. As the conversation proceeded, however, Dr. Herken began to sense that the individual was not in complete command of his faculties. Mr. Jordan spoke of things he had accomplished for Mental Images. He also said that he would send the missing information I had been promised (i.e. the status chart) on the same day by fax, but nothing arrived on that day or ever since. He seemed to be confused about when he had done certain things in the past.

29. My cousin left that meeting concerned that Mr. Jordan was no longer competent to handle my company's patent work.

30. On 12 July 2005, based on our new patent counsel's inspection of the USPTO's patent records, I was advised that the above-referenced applications had gone abandoned, almost all of them for failure to file a response to Missing Parts (fees and declarations). We have never received a Notice of Abandonment or any other information suggesting that the cases were abandoned.

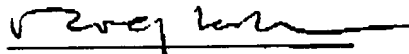
To the contrary, in our correspondence and other contacts, Mr. Jordan gave us the impression of being in control of the patent portfolio.

I HEREBY DECLARE that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

Mental Images GmbH


Dated: JULY 28, 2005

  
By: Rolf Herken  
President and Chief Executive Officer

Address: Fasanenstrasse 81  
10623 Berlin  
Germany  
Phone: ++49-30-315 9970  
Fax: ++49-30-315 997 33  
Email: [rolf@mentalimages.com](mailto:rolf@mentalimages.com)

I hereby confirm that the signature above was signed in my presence by Mr. Rolf Herken, President and Chief Executive Officer of mental images GmbH, Fasanenstr. 81, 10623 Berlin, Germany, who is known to me personally.

UR.N. 6537/2005  
Berlin, July 28, 2005

  
Martin Heidemann  
Notary Public in Berlin, Germany



## EXHIBIT A

> ----- Original Message -----

> From: "Ulrich R Herken" <urh@herken.org>

> To: "'Rolf Herken'" <rolf@mental.com>

> Sent: Friday, June 24, 2005 04:17

> Subject: Rick Jordan

>

>

>>

>> Lieber Rolf,

>>

>> das war nun kein Problem fuer mich, wird aber wahrscheinlich

>> eins fuer Dich...

>>

>> Bin heute bei Jordan vorbeigefahren. Habe 2x geklingelt - nix.

>> Auto vor der Tuer, Aussenbeleuchtung und innen Lampen an.

>> Mit dem Nachbarn geredet, der gerade seinen Rasen maehte. Der sagte

>> mir das Jordan eigentlich da sei. Nach seiner Aussage wohnt wohl auch

>>

>>

>>

>> Als ich dann endlich wieder abfahren wollte sah ich, dass die Haustuer

>> aufging und jemand die Zeitung und Post reinholte. Dies war um 17 Uhr...

>> Habe Hallo gerufen und ihn abgefangen bevor er die Tuer wieder zumachen

>> konnte. Vom ersten Eindruck wuerde ich sagen, mein Klingeln hat ihn

>> geweckt: unrasiert, verwirrt, im Schlafanzug.

>>

>> Habe ihm Dein Leid geklagt. Er war der Meinung, dass er Euch doch vor

>> kurzem ein Fax geschickt haette wegen der letzten "office action" des

>> Patentamtes. Einer der wichtigsten Antraege, meinte er, und es saehe so

>> aus, als wenn er mit nur geringen Aenderungen durchgehen wuerde...?

>> Versprach mir, noch heute das Fax noch einmal zu schicken.

>>

>> Taute zunehmend auf und wurde waehrend des Gespraechs auch etwas

>> kohaerenter.

>> Erzaehlte etwas davon, dass er wegen eines "Hautproblems" laengere Zeit

>> Cortison genommen haette und ihm das garnicht bekommen waere. Er waere

>> Nachmittags einfach umgekippt, und so. Aber seit Mitte Mai wuerde er es

>> nicht mehr nehmen und es wuerde ihm jetzt zunehmend besser gehen. Etc.

>> pp.

>> Er wuerde jetzt bis Ende des Monats das Projekt fuer Euch zu Ende

>> bringen,

>> und es wuerde ihm solchen Spass machen, mit Euch zu arbeiten weil die

>> Thematik so interessant waere, u.s.w.

>>

>> Wenn Du jetzt wieder nichts von ihm hoerst (oder eigentlich auch wenn Du

>> von ihm hoeren solltest) bleibt Dir, fuerchte ich, nichts anderes

uebrig,

>> als Euren andern Patentanwalt dort vorbeizuschicken um die Unterlagen zu

>> sichten und die Basisverantwortung zu uebernehmen. Jordan

>> alleinverantwortlich

>> weitermachen zu lassen ist m.E. ein Risiko, dass die Firma nicht



eingehen  
>> sollte.  
>>  
>> Es ist schwierig, diese Begegnung zu beschreiben. Wenn Du willst,  
koennen  
>> wir  
>> auch nochmal telefonieren. Sag mir wann und wo ich Dich anrufen soll,  
>> und  
>> ich melde mich bei Dir. Hatte schon ueberlegt Dich heute nach dem  
Treffen  
>> anzurufen, war aber schon nach Mitternacht.  
>>  
>> Herzliche Gruesse,  
>>  
>> Uli  
>>  
>> --  
>> Ulrich R. Herken (urh@herken.org)

EXHIBIT B

Rolf Herken <rolf@mental.com>

07/14/2005 02:48 PM

To: david.jacobs@gesmer.com  
cc: peter.moldave@gesmer.com, silvia@mental.com,  
sunshine.limanni@gesmer.com  
Subject: Re: Fw: Rick Jordan

David,

the translation is included herebelow.

Kind regards,

Rolf

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Letter from Dr. Ulrich Herken to Rolf Herken  
(sent June 23 (EST) / June 24 (CET))  
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Dear Rolf,

This was not a problem for me, but most likely it will  
be one for you ...

I went to Mr. Jordan's house today. I rang twice, no response.  
A car was parked in front of the house. External lights and lights  
inside the house were on. I talked to Mr. Jordan's neighbor who was  
mowing his lawn. He said that he thought that Mr. Jordan was at home.

[REDACTED]

When I was finally about to leave, I saw that the front door  
to Mr. Jordan's house was opened and someone was picking up  
the newspaper and the mail. Mind you, it was 5 p.m. ...  
I called out to the person and wanted to catch him before he  
shut the door. My first impression was that I had woken him  
up: unshaved, confused, wearing pajamas.

I spoke to him and told him about your woes. In his opinion, he had  
recently sent you a fax pertaining to the last "office action"  
of the Patent Office. One of the most important applications,  
as he said, and it would look as if it would pass with only  
minor changes. He promised me to resend the fax today.

While we were talking, he became more and more open and more coherent. He said that because of a "dermatological problem" he had taken cortisone over an extended period of time which had not agreed with him at all. It had made him faint in the afternoon, and so on. But since mid-May he had stopped taking it and was feeling better and better, etc. pp. He would now finish the project for you until the end of the month, and he was enjoying working for you so much because the subject matter was so interesting, and so on.

Should you again not hear from him (but, actually, even in case you should), I am afraid you can only send your other patent attorney to Mr. Jordan and have him look through the documents and to take over the general responsibility for your matters. In my opinion, leaving the responsibility for these matters solely with Mr. Jordan would be a risk that the company should not take.

It is difficult to really describe my meeting with Mr. Jordan. If you wish, we can speak on the telephone about it. Let me know when you want to take my call. I thought I'd call you right after the meeting, but it was already after midnight.

Kind regards,

Ulrich R. Herken (urh@herken.org)

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